



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/878,177	06/18/97	IWAMOTO	M SOEI-5001

MORGAN LEWIS & BOCKIUS
1800 M STREET NW
WASHINGTON DC 20036

HM31/1026

EXAMINER

WILSON, M

ART UNIT

PAPER NUMBER

1633

DATE MAILED: 10/26/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/878,177

Applicant(s)
Iwamoto et al.

Examiner
Wilson, Michael C.

Group Art Unit
1633



- ☐ Responsive to communication(s) filed on _____.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-19 is/are pending in the application.
- Of the above, claim(s) none is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-19 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1633

DETAILED ACTION

Claims 1-19 are under consideration in the instant application.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1 and 5, drawn to protein, classified in class 530, subclass 350.
 - II. Claim 2, drawn to DNA, classified in class 536, subclass 23.1.
 - III. Claims 3-4, 15, 17 and 19, drawn to pharmaceutical compositions comprising a protein, classified in class 514, subclass 2.
 - IV. Claims 6-7, drawn to antibodies, classified in class 530, subclass 387.1.
 - V. Claims 8-9 and 12, drawn to a method of measuring gene expression using a probe against DNA, classified in class 435, subclass 6.
 - VI. Claims 8 and 10-13, drawn to a method of measuring gene expression using an antibody, classified in class 436, subclass 500.
 - VII. Claim 14, drawn to a method of screening compounds using transformed cells, classified in class 435, subclass 455.
 - VIII. Claims 16 and 18, drawn to a pharmaceutical composition comprising DNA, classified in class 514, subclass 44.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups 1-VIII are unrelated. Inventions are unrelated if it can be shown that they

Art Unit: 1633

are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case, Group I is different than Groups II-VIII because the protein of Group I has a separate use which is as a dietary source of nutrition. Group II is different than Groups III-VIII because the DNA of Group II has different function which is to make protein. Group III is different than Groups IV-VIII because the pharmaceutical compositions comprising protein have a different function which is therapy and differ from Group VIII because they require separate and distinct protocols and reagents. Group IV is different than Groups V-VIII because the antibodies of Group IV have a separate use which is to isolate proteins. Group V is different than Groups VI-VIII because the method of measuring gene expression using a probe against DNA requires separate and distinct protocols and reagents than the method of Group VI and because it has a separate use than Groups VII and VIII which is measuring gene expression. Group VI is different than Groups VII and VIII because it has a separate use which is measuring gene expression. Group VII is different than Group VIII because the method of screening compounds using transformed cells of Group VII is of separate use than the pharmaceutical composition of Group VIII and requires separate and distinct protocols and reagents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Wilson whose telephone number is (703) 305-0120. The examiner can normally be reached on Monday through Friday from 8:30 am to 5 pm.

Serial Number: 08/878,177

Page 4

Art Unit: 1633

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine C. Chambers, can be reached on (703) 308-2035. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Michael C. Wilson
October 21, 1998



DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800/630